

Notice of Allowability

Application No.

09/536,945

Examiner

Tongoc Tran

Applicant(s)

EPSTEIN ET AL.

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2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 10/18/2004.
2. ☒ The allowed claim(s) is/are 1-40.
3. ☒ The drawings filed on 27 June 2000 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

DETAILED ACTION

1. This office action is in response to Applicant's Appeal Brief filed on 10/18/2004. Claims 1-40 are pending.

Allowable Subject Matter

2. Claims 1-40 are allowed.

The following is an examiner's statement of reasons for allowance:

The present invention is directed to a number of data items selected for inclusion in a data set so as to discourage a transmission of the entire set over a limited bandwidth communication path, such as the Internet. The data set includes an entirety parameter that is used to determine whether the entirety of the data set is present. In a preferred embodiment, the entirety parameter is a hash value that is based on watermarks of each data item. When presented for rendering, the watermarks of the data items in the presented material are read and a hash value based on the presented watermarks is computed. A mis-match between the computed hash value and the entirety hash value contained in the data set indicates that less than the entirety of the data set is being presented and the rendering is prohibited (Abstract). The cited prior art, Kurowski (U.S. Patent No. 6,553,127) teaches embedding and detecting a watermark in a data stream and the second prior art, Leighton (U.S. Patent No. 5,949,885) teaches a digital watermarking scheme that is robust against collusion by multiple individual who each possess a watermarked copy of the data, in one embodiment, Leighton teaches, "*the original offset watermark vectors are computed using a secret*

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random hash function H, The function H maps copyright and other information that the user desires to embed in the document (e.g. "this picture is the property of XYZ Corp., unauthorized copying is forbidden") to the sequence of numbers $W=w_1 \dots w_n$ that was used as the original offset watermark vector. The sequence of numbers preferably has same structure and function as discussed above and appear to be random, but the sequence is easily reconstructed given the secret function H and the underlying information to be inserted into the document..." (col. 5, lines 65-col. 6, line 16). Examiner relies on this portion of the reference to teach Applicant's claimed feature of "creating an entirety parameter based on a plurality of security identifier associated with data items". In response to Applicant's contention that Leighton fails to teach the above claimed feature, Examiner explains in the Final Rejection that "[I]n the Summary of the Specification, Applicant discloses "in a preferred embodiment, the entirety parameter is a hash value that is based on watermarks of each data item (Specification, page 3, lines 15-16). In Leighton the hash function that generates the hash value from the watermark is used as an identifier to identify the variation of the watermark (col. 5, line 65-col. 6, line 16)". However, Applicant argues in the Appeal Brief that "a randomly generated offset watermark vector as taught by Leighton does not correspond to an entirety parameter that is based on security parameters associated with data items in a data set, as specifically claimed by the Applicants. In the embodiment cited in the final Office action, Leighton teaches a hash function that maps an identifier of the content material to a sequence of apparently random numbers based on information that is added to

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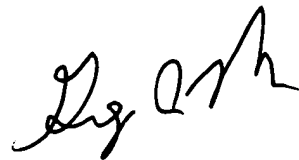
the content material, such as a copyright notice. Of particular note, neither the identifier of the content material nor the sequence of random numbers can be said to be security identifier that are associated with data item comprising the content material". Therefore, in light of Applicant's above arguments along with arguments presented in the Appeal Brief, the Final Rejection is withdrawn.

3. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tongoc Tran whose telephone number is (571) 272-3843. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571) 272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.





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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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March 29, 2005
GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100